

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Merton Bernfield and Ofer Reizes

Serial No: 08/965,356

Art Unit: 1614

Filed: November 6, 1997

Examiner: K. Weddington

For: *METHODS AND REAGENTS FOR REGULATING OBESITY*

Assistant Commissioner for Patents
Washington, D.C. 20231

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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

Responsive to the Restriction Requirement mailed July 21, 1998, Applicants elect to prosecute group II, claims 10-15, with traverse.

Please cancel claims 16-18. Claims 19-25 of the application as filed were cancelled in response to a restriction requirement mailed April 20, 1998. Claims 1-15 are pending in the application.

The claims have now been divided into three groups: group I, claims 1-9 drawn to a non-human transgenic animal constructed genetically with a promoter and a nucleic acid molecule encoding a syndecan; group II, claims 10-15, drawn to a method for screening compounds which can alter body weight; and group III, claims 16-18, drawn to a composition.

Applicants elect to prosecute group II, with traverse. Applicants submit that the claims of group I should be examined as well at this time on their merits. To be valid, a restriction requirement must establish both that (1) the "inventions" are either independent or distinct, and (2) that examination of more than one of the "inventions" would constitute a burden to the Examiner. However, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even

though it includes claims to distinct or independent inventions." (MPEP § 803). It is believed that it would require no further searching on the part of the Examiner to search the claims of group I, since the art should be substantially the same. The group I claims are drawn to a non-human transgenic animal constructed genetically with a promoter and a nucleic acid molecule encoding a syndecan and the group II claims are drawn to a method for screening compounds which can alter body weight which involves use of the animals of the group I claims. A search for prior art relating to the group II claims will necessarily encompass a search for prior art relating to the group I claims.

Accordingly, Applicants question whether a sufficient burden exists for the division of groups I and II. Applicants note that groups I and II are both classified in class 435.

For these reasons, Applicants respectfully request rejoinder and examination of groups I and II, claims 1-15. A copy of all pending claims is attached to this document as an appendix, for the convenience of the Examiner.

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It is believed that no additional fee is required with this submission. The Commissioner is hereby authorized to charge any other fees which may be required, or credit any overpayment, to Deposit Account No. 01-2507.

Respectfully submitted,



Collen A. Beard
Reg. No. 38,824

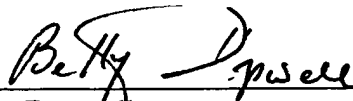
Date: August 20, 1998

ARNALL GOLDEN & GREGORY, LLP
2800 One Atlantic Center
1200 West Peachtree Street
Atlanta, Georgia 30309-3450
404/873-8102
404/873-8103 (fax)

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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this Paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date shown below with sufficient postage as first-class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.



Betty Dopwell

Date: August 20, 1998